



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Johan Ulin, et al. CONF. NO.: 7386
SERIAL NO.: 10/539,045 ART UNIT: 1797
FILING DATE: March 6, 2006 EXAMINER: Michael White
TITLE: VESSEL FOR PERFORMING MICROWAVE-ASSISTED
CHEMISTRY ON SMALL VOLUMES OF REAGENTS
ATTY. DKT. NO.: 12090-000016/US

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October 27, 2010

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed August 2, 2010, the following remarks are respectfully submitted in support of the Pre-Appeal Brief Request for Review in connection with the above-identified application. The Pre-Appeal Brief Request for Review is being concurrently submitted with a Notice of Appeal.

Claims 15-29 are currently pending in the present application. Applicants respectfully request the designated panel of examiners (Panel) to review the rejection of claims 15-21 and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Jennings, U.S. Patent Publication No. 2002/0101310 in view of Commarmot et al. ("Commarmot"), U.S. Patent No. 4,693,867; and claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Jennings in view of Commarmot, and further in view of Bennett et al., U.S. Patent No. 5,520,886.

Claim Rejections under 35 U.S.C. § 103 (Jennings/Commarmot)

Claims 15-21 and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Jennings in view of Commarmot. Applicants respectfully traverse this rejection for the reasons below.

Cited Art Fails to Disclose All the Limitations of the Claims

Applicants respectfully submit that the Jennings and the Commarmot references, individually or in combination, fail to disclose, or even suggest, *inter alia*:

the cap **extending over the diaphragm and the sleeve** so as to secure the vessel to the sleeve while clamping the diaphragm for sealing the open upper end of the vessel. (*emphasis added*)

In particular, Applicants respectfully submit that none of the applied references disclose the cap 40 extending over the diaphragm 30 and the sleeve 20. In this regard, FIG. 5 is reproduced below.

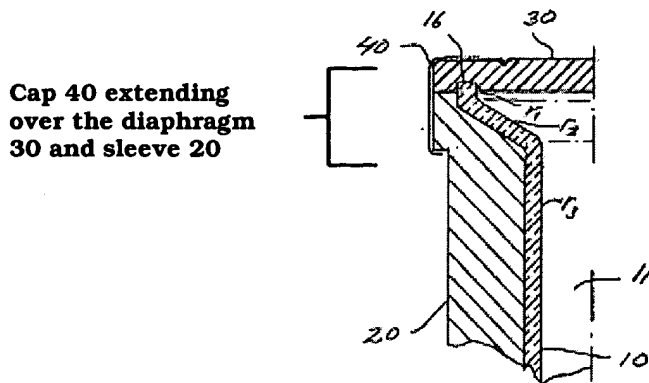


Fig. 5

In the outstanding Final Office Action, the rejection is based on an assertion that the collet assembly “91” of Jennings corresponds to the “cap” member of claim 15. In particular, the Examiner asserts that “[t]he collet assembly 91 contacts the septum 134 at 106 (“extending over the diaphragm”) and further extends over the attenuator 33 at 107 (“extending over the sleeve”).”¹ Applicants respectfully disagree.

¹ See Final Office Action mailed August 2, 2010, page 8, paragraph 4.

Specifically, as shown in FIG. 11 of Jennings, the collet 91 does not “**extend over**” the attenuator (“sleeve”), but merely positioned within (or inside) the attenuator 33. Thus, the collet 91 does not “extend over” the septum 134 (“diaphragm”) and the attenuator 33 (“sleeve”).

Accordingly, Applicants respectfully submit that the Jennings and the Commarmot references, individually or in combination, fail to disclose, or even suggest, “the cap extending over the diaphragm and the sleeve so as to secure the vessel to the sleeve while clamping the diaphragm for sealing the open upper end of the vessel,” as recited in claim 15.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 1.

In view of the above, Applicants respectfully submit that the Jennings and the Commarmot references fail to teach or suggest each and every element of claim 15, and therefore, claim 15 is allowable over the cited prior art. Claim 29 is also allowable for the similar reasons discussed above regarding claim 15. Claims 16-21 and 23-28 are dependent from claim 15, and therefore, also allowable. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

No Motivation to Modify the Prior Art in the Manner Asserted by Examiner

Further, Applicants respectfully submit that the Examiner is mis-applying the law regarding motivation to combine, and respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness for at least the reasons set forth below.

In the outstanding Final Office Action, the Examiner contends that “it would have been obvious to one of ordinary skill in the art to substitute the sleeve 86 of Commarmot with the attenuator of Jennings because they are known sleeves to hold microwave reaction vessels in a defined position during the reaction.”² See *Final Office Action* mailed August 2, 2010, page 5, first full paragraph. However, Applicants respectfully submit that the mere *substitution* of a sleeve member is insufficient to establish a motivation to combine. In particular, Applicants note that the relevant

² Applicants further submit that the above statement is merely conclusory and do not comprise an “*explicit rationale*” as required by *KSR Int’l Co. v. Teleflex, Inc.* (550 U.S. at 398, 82 USPQ2d at 1396 (2007)).

inquiry is not whether the Commarmot reference *discloses* a sleeve with a widening portion, but rather whether one of ordinary skill in the art would *desire* to combine the Commarmot and the Jennings references in order to arrive at the claimed invention. *See, e.g.*, MPEP § 2143.01(III), which states “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination,” citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). That is, establishing motivation requires the Examiner to demonstrate *why one of ordinary skill in the art, absent the teachings of Applicants’ application, would want to substitute the sleeve member of Commarmot with the sleeve member of Jennings*. For instance, the Commarmot reference discloses a cover 90 in abutment on the upper edge of ring 88 including a tube 95 in permanent relation with a supply pipe leading to a pumping and suction unit (*see col. 8, lines 40-50*). The pumping and suction unit is started up in synchronized manner necessary for ensuring removal of the fumes and vapors released by the reaction (*see, e.g., col. 10, line 35-42*). Accordingly, it follows that there cannot be any diaphragm (as taught in Jennings) in the apparatus according to Commarmot because a diaphragm would keep such fumes/vapors in the reaction vessel and the suction unit would not be able to remove the fumes/vapors.

Moreover, it is respectfully submitted that the Commarmot reference teaches away from “sealing” the diaphragm. More specifically, there cannot be any diaphragm in the apparatus according to Commarmot, because again such a diaphragm would keep fumes/vapors locked inside the reaction vessel, and the suction unit would not be able to remove the fumes/vapors through the cover 90 as required.

Furthermore, even if the skilled person would be motivated by Commarmot to replace the sleeve member in the device according to Jennings (*in which Applicants do not admit to or agree to*), this could only be done in a certain manner. The most obvious way being simply to replace the vessel (14) of Commarmot with the vessel (105) of Jennings. However, there is no teaching, suggestion or motivation in either document to use a cap to clamp together the vessel, diaphragm and the sleeve together. The sleeve (33) of Commarmot is already clamped by jaws (82) and it is not obvious how further clamping means should be introduced. Therefore, the rejection failed to articulate a proper rationale to support an obviousness rejection.

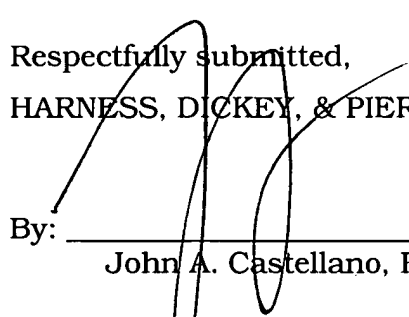
In view of the above, Applicants respectfully submit that one of ordinary skill in the art would not have combined the teachings of the Jennings and the Commarmot references in the manner used to reject the claims, and that the proposed combination of the Jennings and the Commarmot references, individually or in combination, fails to teach or suggest all of the elements of claims 15 and 29. Thus, no *prima facie* case of obviousness has been established. Accordingly, claims 15 and 29 are allowable over the Jennings and the Commarmot references. Dependent claims 16-21 and 23-28 depend from claim 15 and are allowable for at least the reasons that claim 15 is allowable. Therefore, Applicants respectfully request that the rejection of claims 15-29 under 35 U.S.C. § 103(a) be favorable reconsidered and withdrawn.

CONCLUSION

For at least the reasons above, Applicants respectfully request the allowance of all the pending claims. Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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